

Remarks

Claims 1-5 were pending in the application. Claims 6-18 were added. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by McIlhenney. This rejection is respectfully traversed.

With regard to the rejection to claim 1, the Examiner states that McIlhenney "teaches in the figures a device for display of gifts comprising a gift holding box having a transparent surface (fig. 1; col. 2, par. 4), a mailing box having a cutout (1, col. 2, par. 2), and a removable opaque panel fitting inside the mailing box (7)." Office action, at 2.

In response, Applicant submits that McIlhenney fails to teach or suggest a gift holding box having a transparent surface. Instead, McIlhenney discloses packing contents of the box in a *tubular member* 12 sealed in a transparent paper. McIlhenney, col. 2, lines 75-79. Specifically, McIlhenney states, "[t]his sealed tray is positioned in the box so that the contents of the tray can be readily inspected through the transparent wrapper...." McIlhenney, col. 2, lines 79-82.

In contrast, Applicant's independent claim 1 recites, "a gift holding box, said box having a transparent surface..." The tray of McIlhenney is not a box for at least the reason that it is described as a *tubular member*. Further, McIlhenney fails to teach or suggest that a surface of its tray, which the Examiner appears to be equating to the gift box, is transparent. In fact, no mention is made as to the transparency of any surface the tray of McIlhenney. McIlhenney merely discloses that a transparent wrapping is used without disclosing that the tray which is itself sealed includes a transparent surface. It is advantageous to have a

transparent surface of a box for at least the reason that the displayed item is visible through that surface for display.

Therefore, for at least these reasons, Applicant respectfully submits that McIlhenney fails to teach or suggest the claimed invention. Accordingly, claims 2-15 which depend from claim 1, should be allowed for at least the same reasons as

Further, with regard to claim 2, the Examiner states that McIlhenney teaches a display panel inside of the gift box. Applicant respectfully disagrees. In making the rejection, the Examiner cites to col. 2, par. 4 of McIlhenney. This citation describes the sealed tray that the Examiner appears to have previously equated to the gift box. Here, it appears that the Examiner is also equating the "display panel" recited in Applicant's claim 1 to the sealed tray of McIlhenney. Therefore, it appears the Examiner is referring to the sealed tray as both the gift box and display panel.

In contrast, Applicant's claim 2 recites, "[t]he device of claim 1 further including a display panel inside of the gift box...." As McIlhenney fails to teach or suggest a display panel, in addition, to the sealed tray, Applicant respectfully submits that claim 2 is not anticipated or made obvious by McIlhenney. A display panel is advantageous for at least the reason that a merchant would have the option of attractively positioning the items for display on the display panel.

Therefore, for these additional reasons, the rejection to claim 2 should be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 3 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McIlhenney. This rejection is respectfully traversed.

With regard to claim 3, the Examiner states, "McIlhenney fails to teach a metal sculpture mounted on the

display panel and the mailing box including printing. It would have been considered a mere design choice to have a metal sculpture mounted on the display panel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a metal sculpture on the display panel of McIlhenney for the purpose of displaying a design to the consumer." Office action, at 3.

Applicant strongly disagrees that it would have been obvious to one of skill in the art to incorporate a metal sculpture on the display panel of McIlhenney. First, Applicant submits that McIlhenney fails to teach or suggest a display panel (as discussed above). Therefore, McIlhenney could not teach or suggest a metal sculpture on a display panel for at least these reasons. Further, McIlhenney was concerned with "display packages for dispensing perishable articles...." Therefore, there is no teaching or suggestion in McIlhenney to substitute the perishable articles for a metal (non perishable) structure, or to include a metal structure in addition to the perishable articles. For, at least this reason, Applicant submits that claim 3 is in condition for allowance.

Further, under MPEP § 2144.03, if an Applicant traverses an assertion that teachings are matters of common knowledge in the art, the Examiner should cite a reference in support of his position. Here, Applicant traverses the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a metal sculpture on the display panel of McIlhenney. Therefore, according to MPEP § 2144.03, the Examiner should cite a reference in support of his position.

With regard to the element of the mailing box incorporating printing, the Examiner refers to Applicant's claim 4. Applicant respectfully submits that it appears that the Examiner intended to refer to Applicant's claim 5 which recites, "wherein the mailing box includes printing."

Therefore, Applicant will refer to claim 5 with regard to this rejection. With regard to this rejection, the Examiner states that McIlhenney "teaches the indicia 14 use to identify the product in the display package. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate printing on the box of McIlhenney for the purpose of identifying the product in the device." Office action, at 3. Here, Applicant traverses the Examiner's assertion that it would have been obvious to incorporate printing on the box of McIlhenney. Therefore, according to MPEP § 2144.03, the Examiner should cite a reference in support of his position.

Further, Applicant submits that McIlhenney fails to teach or suggest printing on the box. Therefore, Applicant submits that claim 5 should be allowed for at least this reason.

Additionally, with regard to new claims 6-16 Applicant submits the following. In McIlhenney, a tubular member is disclosed. In contrast, with regard to claim 6, the gift holding box is rectangular.

Also, unlike the tubular member of McIlhenney, the entire gift holding box, as recited in Applicant's claim 7, is transparent and six-sided. The tubular member of McIlhenney is not entirely transparent nor is it six-sided.

In Applicant's claim 8, the gift holding box includes a transparent top section and a transparent bottom section. In McIlhenney, a transparent top and bottom section of a box are not disclosed.

A transparent gift box is advantageous for at least the reason that the displayed item is visible from all sides. In McIlhenney, the chocolates may not be viewed from all sides as the tray is not disclosed as being transparent.

Further, McIlhenney, fails to teach or suggest that the mailing box is uncovered for mailing, the printing of the removable panel includes sender identification lines or mailer

identification lines, or a metering stamp or a stamp is disposed on said removable opaque panel, as recited in Applicant's claims 9-13. The device of the present invention is advantageous for at least the reason that it need not be wrapped for mailing, thus no additional material is required for mailing, unlike McIlhenney which discloses wrapping the box for shipping. Specifically, McIlhenney states that "[f]or shipping, the entire package preferably described, will be banded with a wrapper of transparent material 14...." McIlhenney, col. 2, lines 84-86. Further, the removable panel of Applicant's claimed invention includes sender or mailer identification lines and/or a metering stamp or stamp. McIlhenney fails to disclose such elements. The removable card with mailing indicia makes shipping much easier and quicker than wrapping the mailer box as disclosed in McIlhenney.

Additionally, McIlhenney, fail to disclose a card or envelope inside of the gift box, as recited in Applicant's claims 14-15. A gift card or envelope inside of the gift box is advantageous for at least the reason that a sender could inscribe the gift card and include it in the gift box with the gift.

With regard to claims 16 and 17, Applicant submits that McIlhenney fail to teach or suggest displaying the gift holding box separately from the mailing box as recited in claim 17 and selling the gift holding box separately from the mailing box as recited in claim 18. Instead, McIlhenney state, "[t]his sealed tray is positioned in the box so that the contents of the tray can be readily inspected through the transparent wrapper when slide 7 is partly withdrawn." McIlhenney, col. 2, lines 80-83. McIlhenney do not disclose displaying the sealed tray separate from the box, nor does it disclose selling the sealed tray separately from the box. The elements of Applicant's claims 16 and 17 are useful and advantageous in that a merchant need not purchase the same

number of mailing boxes and gift holding boxes. This may create a savings in cost for the merchant as it could reduce freight weight. One mailing box could be re-used for many different gift holding boxes. Further, a gift holding box may be bought first and then the mailing box may be purchased later or vice-versa.

Further, Applicant submits that McIlhenney fails to teach or suggest that when an item is intended to be viewed through the cutout that the removable panel is retained in the mailing box and disposed on a surface opposing the transparent surface as recited in claim 18. Such storing of the panel is advantageous for at least the reason that when shipping numerous devices including various types of items within gift holding boxes nested within the mailing boxes, the contents of the box are immediately visible by the receiver/merchant. Also, the merchant or consumer may easily remove the panel from the second surface of the mailing box and position the panel such that it is disposed upon the transparent surface of the box so that it is in condition for mailing. In contrast, when the boxes in McIlhenney are shipped, McIlhenney teaches that the panel is positioned adjacent to the cutout so that the wording on the panel is visible, not the actual items within the box. Further, McIlhenney fails to teach or suggest positioning the panel on a surface opposing a transparent surface at any time.

Therefore, for at least the reasons submitted, Applicant submits that claims 6-18 are in condition for allowance.

Conclusion

For at least the reasons submitted above, Applicant respectfully submits that claims 1-17 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signed: Sally Azevedo
Typed Name: Sally Azevedo

Date: November 18, 2004

Respectfully submitted,



Gina McCarthy

Reg. No. 42,986

P.O. Box 2-E

San Jose, CA 95109-0005

(408) 297-9733